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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/628,014

07/25/2003

John Bruce Clayfield Davies

7194-4

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7590

10/01/2008

WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204-5137

EXAMINER

HOFFMAN, MARY C

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

10/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/628,014	Applicant(s) DAVIES, JOHN BRUCE CLAYFIELD	
	Examiner MARY HOFFMAN	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/17/2008 has been entered.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The term "tie rod" is not found in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13, 15-19 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Davies (GB 2268068).

Davies discloses a bone nail (FIGS. 1 and 2) comprising a nose portion and an opposing portion coupled via a tie rod, the bone nail including at least two expansion portions longitudinally spaced between the nose portion and the opposing portion so as to be positionable on either side of a bone fracture during use, wherein each expansion portion is configured to be radially expanded under a compressive force applied by the nose portion and the opposing portion coupled via the tie rod, each expansion portion having at least one portion, at least one characteristic of which is selected to be different to a corresponding at least one characteristic of at least one other portion of the expansion portion (page 9). The at least one characteristic comprises a thickness and/or width of the at least one portion and the at least one other portion. The expansion portions comprise at least one elongate portion having a pair of elongate slots on either side thereof. The at least one portion comprises a first end of the at least one elongate portion and a second end of at least one elongate portion. The at least one other portion comprises a mid portion of the elongate portion forming a remainder of the elongate portion. The first end and/or second end of the elongate portion is thinner or thicker and/or narrower or broader than an adjacent portion of the at least one elongate portion. The at least one portion further comprises a first end of at least one slot and a second end of at least one slot. The at least one other portion comprises a mid portion of the slot forming a remainder of the slot.

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The first end and/or the second end of at least one slot is broader than an adjacent portion of the at least one slot.

Davies discloses a bone nail comprising a nose portion and an opposing portion coupled via a tie rod, the bone nail including at least one-two expansion portions longitudinally spaced between the nose portion and the opposing portion so as to be positionable on either side of a bone fracture during use. wherein each expansion portion is configured to be radially expanded under a compressive force applied by the nose portion and them opposing portion coupled via the tie rod, wherein each expansion portion is shaped to elastically bow outwards when a compressive force is applied axially to the expansion portion.

Davies discloses a bone nail adapted to be received within a bone cavity and comprising a nose portion and an opposing portion coupled via a tie rod, the bone nail including at least two expansion portions longitudinally spaced between the nose portion and the opposing portion so as to be positionable on either side of a bone fracture during use, wherein each expansion portion is configured to be capable of being radially expanded under a compressive force applied by the nose portion and the opposing portion coupled via the tie rod, wherein at least one of the expansion portions comprises at least one longitudinal portion fixed at either end to means which engage a compression coupling, wherein a profile of the at least one longitudinal portion is narrowed at one or both ends of the at least one longitudinal portion. The expansion portions are made of a stiffly resilient plastics material, titanium or titanium alloy. A plurality of longitudinal portions substantially equidistant spaced around a circumference

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of the expansion portion are provided. The longitudinal portion has a stepped or curved profile.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davies (GB 2268068) in view of Gianezio et al. (U.S. Patent No. 4,520,511).

Davies discloses the claimed invention except for serrations.

Gianezio et al. disclose serrations to increase gripping effect (col. 2, lines 10-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the device of Davies with serrations in view of Gianezio to increase gripping effect.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARY HOFFMAN whose telephone number is (571)272-5566. The examiner can normally be reached on Monday-Thursday 10:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mary C. Hoffman/
Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733